

REMARKS

Claims 1-8, 10-18, 20-31, and 33-37 are currently pending in the subject Application.

Claims 9, 19, and 32 were previously canceled without prejudice or disclaimer.

Claims 1-8, 10-11, 13-18, 20-21, 23-31, 33-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. (hereinafter "*Cupps*") in view of U.S. Patent No. 6,330,554 to Altschuler (hereinafter "*Altschuler*") further in view of U.S. Patent No. 4,971,406 to Hanson (hereinafter "*Hanson*") and U.S. Patent No. 5,895,454 to Harrington (hereinafter "*Harrington*").

Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Altschuler*, *Hanson* and *Harrington*, and further in view of U.S. Patent No. 4,797,818 to Cotter (hereinafter "*Cotter*").

Applicant initially notes that the Examiner fails to properly cite the Camaisa reference. In particular the Examiner states that "while not applied, the reference to Camaisa (US 5,845,263) also discloses a data base to include availability information of a food item." (27 October 2009 Non-Final Office Action, page 5). However, even though the Examiner states that "while not applied," the Examiner relies on the Camaisa reference to disclose "a data base to include availability information of a food item." Since the Examiner has not properly cited the Camaisa reference, Applicant is submitting herewith an Information Disclosure Statement citing the Camaisa reference. In addition, Applicant respectfully submits, that even though Applicant is citing the Camaisa reference disclosed by the Examiner in an Information Disclosure Statement, Applicant believes that the present invention is not disclosed or fairly suggested by the Camaisa reference, and therefore, traverses the rejection of Applicant's claims for at least the reasons recited below.

Applicant respectfully submits that all of Applicant's arguments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner,

Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application.

I. Rejections Under 35 U.S.C. § 103(a)

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Altschuler*, further in view of *Hanson* and *Harrington*. Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Altschuler*, *Hanson* and *Harrington*, and further in view of *Cotter*.

Applicant respectfully submits that independent Claims 1, 13, 23, and 24 in their current form contain unique and novel limitations that are not disclosed by *Cupps*, *Altschuler*, *Hanson* and *Harrington*, either individually or in combination. Thus, Applicant respectfully traverses the Examiner's obviousness rejection of Claims 1-37 under 35 U.S.C. § 103(a) over the proposed combination of *Cupps*, *Altschuler*, *Hanson*, *Harrington*, and *Cotter*, either individually or in combination.

More specifically, Applicant respectfully submits that none of the references relied upon by the Examiner disclose "***one or more databases comprising . . . real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers***, the real-time availability information ***reflecting a current shortage*** of the one or more particular food items available ***from one or more of the plurality of unaffiliated sellers***," as required by Applicant's Claims 1, 13, 23, and 24. In fact, the Examiner's Non-Final Office Action is silent and thus makes no assertion that *Cupps*, *Altschuler*, *Hanson*, *Harrington*, and *Cotter*, either individually or in combination, disclose this element of Applicant's Claims.

In rejecting Applicant's claims, the Examiner states the following:

In addition to the teaching in *Harrington*, *Cupps* teaches to communicate with the seller if there is a problem with a food order (column 11, paragraph beginning line 13) wherein the problem inherently would include a shortage of food. Finally, **while not applied, the reference to Camaisa (US 5,845,263) also discloses a**

data base to include availability information of a food item (column 14, paragraph beginning line 10).

(27 October 2009 Non-Final Office Action, page 5). (Emphasis added). Applicant respectfully submits that *Cupps* and U.S. Patent No. 5,845,263 to Camaisa (hereinafter “*Camaisa*”), which the Examiner relies upon fail to disclose the above-referenced limitations of Applicant’s claims. For further clarification, Applicant respectfully directs the Examiner’s attention to column 11, lines 13-34 of the specification of *Cupps*, provided below, on which the Examiner relies:

If the IVR procedure 134 encounters any failures in retrieving the vendor's response (step 332-N), the online order procedure 132 initiates one or more failure recovery 15 actions to rectify the failure. For example, if the vendor 108 does not respond to a telephonic order, a manual telephone call can be made to the vendor 108 in order to ascertain the nature of the problem or to obtain the response. If the IVR procedure 134 receives a response from the 20 vendor 108 (step 332-Y), the online order procedure 132 transmits a notification to the customer indicating the status of an order and updates the order database 128 with the status thereby completing the order (step 336). Notification to the customer can be by an email message, or other 25 communication medium, and can include an expected delivery time.

In addition to the aforementioned steps, the online order procedure 132 can also transmit to the vendor 108 directions to the customer's location either as a facsimile transmission, 30 as a telephone call, email message, and the like. Likewise, the online order procedure 132 can transmit through any medium directions to a vendor's location to a customer requesting takeout service. (Emphasis added).

As shown above, the portion of *Cupps* relied on by the Examiner merely discloses, among other things, a response to a failure to retrieve a response form a vendor and cites an example of placing a manual telephone call to the vendor to ascertain the nature of the problem. This is not analogous to a database having *real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers*, the real-time availability information *reflecting a current shortage* of the one or more particular food items available *from one or more of the plurality of unaffiliated sellers*,” as required by Applicant’s claims. More simply stated, placing a manual telephone call to determine the reason for a lack of response from a vendor does not in any manner equate to a database providing real-time availability information reflecting a current shortage of one or more food items from a plurality of unaffiliated sellers. *Cupps* is silent,

and therefore, fails to disclose, among other things, the above-referenced limitation of Applicant's claims.

While the Examiner does not formally apply *Camaisa* in rejecting Applicant's claims, the Examiner points to column 13, line 54 through column 14, line 19 of the specification of *Camaisa*, provided below, as an alternative reference that provides disclosure of the limitations of Applicant's claims discussed in detail above:

III. MENU CREATION PROCESS

Menu categories, food items for each category, nutritional and preparation text are entered in a database for each food item. Importantly, the food items are associated with an image of that food item by means well-known in the database art. ***This data is stored on the local database of the stand alone units or on a common database for networked implementations.***

IV. DATABASE STRUCTURE

The multimedia database is created using commercially available relational database management software. Initially Microsoft Access will be used. Other relational database packages such as Paradox, Oracle, or Sybase may be used for different implementations of the product.

Operation

The Multimedia database employs a normalized relational data model. Index files are generated using the relational database management system (RDBMS) to increase the system performance and allow rapid random access to individual data items.

Database Object

The data are grouped into logical entities or database objects to increase speed and flexibility of the different implementations of the IVO products. For instance, ***a food item has associated with it, a picture, a description, an availability, a food category, etc. All of these items grouped together represent a Database Object. Index files allow for rapid access to each individual Database Object that requires an index.*** (Emphasis added).

Applicant respectfully submits that the Examiner similarly to references formally cited against Applicant's claims, *Camaisa* also fails to disclose ***"one or more databases comprising . . . real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers, the real-time availability information reflecting a current shortage of the one or more particular food items available from one or more of the plurality of unaffiliated sellers,"*** as required by Applicant's claims. More specifically, as shown above, *Camaisa* discloses,

among other things, a database having information relating to a food item stored therein for use in creating a user-selectable menu on a kiosk or other location within a restaurant to expedite customer ordering. The mere mention of item availability is insufficient to disclose “*real-time availability information reflecting a current shortage of the one or more particular food items available from one or more of the plurality of unaffiliated sellers,*” as required by Applicant’s claims. *Camaisa* fails to provide any disclosure of the data originally entered into the database being updated to reflect real-time availability information reflecting a shortage of a food item. Thus, *Camaisa* is silent, and therefore, fails to disclose the above-referenced elements of Applicant’s claims.

Similarly, *Altschuler, Hanson, Harrington*, and *Cotter* also fail to disclose these limitations of Applicant’s claims and there is no teaching in any of the references that suggests that it would have been obvious to combine the disclosures of any these references to arrive at Applicant’s claimed invention as recited in Applicant’s claims, particularly the limitation “*one or more databases comprising . . . real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers, the real-time availability information reflecting a current shortage of the one or more particular food items available from one or more of the plurality of unaffiliated sellers.*” Accordingly, Applicant respectfully submits that the Examiner’s obviousness rejections under 35 U.S.C. § 103(a) of Claims 1-8, 10-18, 20-31, and 33-37 over *Cupps, Altschuler, Hanson, Harrington, Camaisa*, and *Cotter*, whether taken individually or in combination, may not be properly maintained. As such, Applicant respectfully requests that the rejections to Claims 1-8, 10-18, 20-31, and 33-37 under 35 U.S.C. § 103(a) be withdrawn.

II. The Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Cupps-Altschuler-Hanson-Harrington-Camaisa-Cotter* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Cupps, Altschuler, Hanson, Harrington, Camaisa*, or *Cotter*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the ***factual findings necessary to establish obviousness*** or even ***an explanation to support the obviousness rejection*** based on the proposed combination of *Cupps*, *Altschuler*, *Hanson*, *Harrington*, *Camaisa*, and *Cotter*. The Office Action merely states that “it would have been obvious for one of ordinary skill in the art to provide the system [of] Cupps with a restaurant rating in addition to other criteria as disclosed in Altschuler,” “it would have been obvious for one of ordinary skill in the art to

communicate the real time delivery time to the customer in Cupps prior to the order being placed,” “it would have been obvious for the person of ordinary skill in the art to communicate the real time delivery time to the customer in modified Cupps in a manner as disclosed in Harrington,” and “it would have been obvious for one of ordinary skill in the art to provide for the automatic selection of a seller in modified Cupps based on real time delivery time as disclosed in Cotter.” (27 October 2009 Non-Final Office Action, pages 2-4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statements are not sufficient to establish the ***factual findings necessary to establish obviousness*** and are not a sufficient ***explanation to support the obviousness rejection*** based on the proposed combination of *Cupps, Altschuler, Hanson, Harrington, Camaisa, and Cotter*. ***Applicant respectfully requests the Examiner to provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.”*** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.*** ***Applicant respectfully requests the Examiner to provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.*** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain***

why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Cupps, Altschuler, Hanson, Harrington, Camaisa, Cotter, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.* The Office Action merely states that "because the rating information would provide the buyer additional information to help in determining which restaurant to buy from," "so that the customer could make a more informed decision," "so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transaction" and "in order to save time to the customer." (27 October 2009 Non-Final Office Action, pages 2-4). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Cupps, Altschuler, Hanson, Harrington, Camaisa, Cotter, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.* Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*" (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Cupps, Altschuler, Hanson, Harrington, Camaisa, and Cotter to render obvious Applicant's claimed invention*. The Examiner's unsupported conclusory statements that “it would have been obvious for one of ordinary skill in the art to provide the system [of] Cupps with a restaurant rating in addition to other criteria as disclosed in Altschuler,” “it would have been obvious for one of ordinary skill in the art to communicate the real time delivery time to the customer in Cupps prior to the order being placed,” “it would have been obvious for the person of ordinary skill in the art to communicate the real time delivery time to the customer in modified Cupps in a manner as disclosed in Harrington,” “it would have been obvious for one of ordinary skill in the art to provide for the automatic selection of a seller in modified Cupps based on real time delivery time as disclosed in Cotter,” [...], “because the rating information would provide the buyer additional information to help in determining which restaurant to buy from,” “so that the customer could make a more informed decision,” “so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transaction” and “in order to save time to the customer” *do not adequately provide clear articulation of the reasons why Applicant's*

claimed invention would have been obvious. (27 October 2009 Non-Final Office Action, pages 2-4).

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Cupps, Altschuler, Hanson, Harrington, Camaisa, and Cotter*, ***Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying what portion(s) of the references provide a teaching, suggestion, or motivation that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings to arrive at the claimed invention in accordance with the Examiner's statement in a prior Office Action that rational G is applicable here.***

III. Applicant's Claims are Patentable over the Proposed *Cupps-Altschuler-Hanson-Harrington-Camaisa-Cotter* Combination

As mentioned above, Claims 1, 13, 23, and 24 are considered patentably distinguishable over *Cupps, Altschuler, Hanson, Harrington, Camaisa, and Cotter*.

With respect to dependent Claims 2-8, 10-12, 14-18, 20-22, 25-31, and 33-37: Claims 2-8, and 10-12 depend from Claim 1; Claims 14-18, and 20-22 depend from Claim 13; Claims 25-31, and 33-37 depend from Claim 24. As set forth above, each of Claims 1, 13, 23, and 24 are considered patentably distinguishable over the proposed combination of *Cupps, Altschuler, Hanson, Harrington, Camaisa, and Cotter*. Thus, dependent Claims 2-8, 10-12, 14-18, 20-22, 25-31, and 33-37 are considered to be in condition for allowance for at least the reason of depending from an allowable claim as well as for further distinctions.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 1-8, 10-18, 20-31, and 33-37 are not rendered obvious by the proposed combination of *Cupps, Hanson, Harrington, Camaisa, and Cotter*. Applicant further respectfully submits that Claims 1-8, 10-18, 20-31, and 33-37 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-8, 10-18, 20-31, and 33-37 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-8, 10-18, 20-31, and 33-37 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

20 January 2010

Date

/Steven J. Laureanti/signed

Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184